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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,606	11/26/2003	Helena L. Palka-Hamblin	200125.447	4190

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EXAMINER	
SAIDHA, TEKCHAND	

ART UNIT	PAPER NUMBER
1652	

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/723,606	PALKA-HAMBLIN ET AL.	
	Examiner	Art Unit	
	Tekchand Saidha	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 July 2004*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-25* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group 1, claim(s) 1-3 (fully), 4 (in-part), drawn to an isolated complex comprising Density Enhanced Phosphatase-1 (DEP-1) of SEQ ID NO: 2, SEQ ID NO: 3, or a polypeptide (SEQ IDNO: 2) encoded by SEQ ID NO: 1 [SEQ ID NO: 3 is part or fragment of SEQ ID NO: 2] and a DEP-1 substrate polypeptide of SEQ ID NO: 4, classified in class 435, subclass 194.

Group 2, claim(s) 1-3 (fully), 4 (in-part), drawn to an isolated complex comprising Density Enhanced Phosphatase-1 (DEP-1) of SEQ ID NO: 2, SEQ ID NO: 3, or a polypeptide (SEQ IDNO: 2) encoded by SEQ ID NO: 1 [SEQ ID NO: 3 is part or fragment of SEQ ID NO: 2] and a DEP-1 substrate polypeptide of SEQ ID NO: 5, classified in class 435, subclass 194.

Group 3, claim(s) 1-3 (fully), 4 (in-part), drawn to an isolated complex comprising Density Enhanced Phosphatase-1 (DEP-1) of SEQ ID NO: 2, SEQ ID NO: 3, or a polypeptide (SEQ IDNO: 2) encoded by SEQ ID NO: 1 [SEQ ID NO: 3 is part or fragment of SEQ ID NO: 2] and a DEP-1 substrate polypeptide of SEQ ID NO: 6, classified in class 435, subclass 194.

Group 4, claim(s) 1-3 (fully), 4 (in-part), drawn to an isolated complex comprising Density Enhanced Phosphatase-1 (DEP-1) of SEQ ID NO: 2, SEQ ID NO: 3, or a polypeptide (SEQ IDNO: 2) encoded by SEQ ID NO: 1 [SEQ ID NO: 3 is part or fragment of SEQ ID NO: 2] and a DEP-1 substrate polypeptide of SEQ ID NO: 7, classified in class 435, subclass 194.

Group 5, claim(s) 1-3 (fully), 4 (in-part), drawn to an isolated complex comprising Density Enhanced Phosphatase-1 (DEP-1) of SEQ ID NO: 2, SEQ ID NO: 3, or a polypeptide (SEQ IDNO: 2) encoded by SEQ ID NO: 1 [SEQ ID NO: 3 is part or fragment of SEQ ID NO: 2] and a DEP-1 substrate polypeptide of SEQ ID NO: 8, classified in class 435, subclass 194.

Group 6, claim(s) 1-3 (fully), 4 (in-part), drawn to an isolated complex comprising Density Enhanced Phosphatase-1 (DEP-1) of SEQ ID NO: 2, SEQ ID NO: 3, or a polypeptide (SEQ IDNO: 2) encoded by

SEQ ID NO: 1 [SEQ ID NO: 3 is part or fragment of SEQ ID NO: 2] and a DEP-1 substrate polypeptide of SEQ ID NO: 9, classified in class 435, subclass 194.

Group 7, claim(s) 1-3 (fully), 4 (in-part), drawn to an isolated complex comprising Density Enhanced Phosphatase-1 (DEP-1) of SEQ ID NO: 2, SEQ ID NO: 3, or a polypeptide (SEQ IDNO: 2) encoded by SEQ ID NO: 1 [SEQ ID NO: 3 is part or fragment of SEQ ID NO: 2] and a DEP-1 substrate polypeptide of SEQ ID NO: 10, classified in class 435, subclass 194.

Group 8, claim(s) 1-3 (fully), 4 (in-part), drawn to an isolated complex comprising Density Enhanced Phosphatase-1 (DEP-1) of SEQ ID NO: 2, SEQ ID NO: 3, or a polypeptide (SEQ IDNO: 2) encoded by SEQ ID NO: 1 [SEQ ID NO: 3 is part or fragment of SEQ ID NO: 2] and a DEP-1 substrate polypeptide of SEQ ID NO: 11, classified in class 435, subclass 194.

Group 9, claim(s) 1-3 (fully), 4 (in-part), drawn to an isolated complex comprising Density Enhanced Phosphatase-1 (DEP-1) of SEQ ID NO: 2, SEQ ID NO: 3, or a polypeptide (SEQ IDNO: 2) encoded by SEQ ID NO: 1 [SEQ ID NO: 3 is part or fragment of SEQ ID NO: 2] and a DEP-1 substrate polypeptide of SEQ ID NO: 12, classified in class 435, subclass 194.

Group 10, claim(s) 1-3 (fully), 4 (in-part), drawn to an isolated complex comprising Density Enhanced Phosphatase-1 (DEP-1) of SEQ ID NO: 2, SEQ ID NO: 3, or a polypeptide (SEQ IDNO: 2) encoded by SEQ ID NO: 1 [SEQ ID NO: 3 is part or fragment of SEQ ID NO: 2] and a DEP-1 substrate polypeptide of SEQ ID NO: 13, classified in class 435, subclass 194.

Group 11, claim(s) 5 (in-part), drawn to an isolated complex comprising Density Enhanced Phosphatase-1 (DEP-1) of SEQ ID NO: 2, SEQ ID NO: 3, or a polypeptide (SEQ IDNO: 2) encoded by SEQ ID NO: 1 [SEQ ID NO: 3 is part or fragment of SEQ ID NO: 2] in specific association with a polypeptide of SEQ ID NO: 14, classified in class 435, subclass 194.

Group 12, claim(s) 5 (in-part), drawn to an isolated complex comprising Density Enhanced Phosphatase-1 (DEP-1) of SEQ ID NO: 2, SEQ ID NO: 3, or a polypeptide (SEQ IDNO: 2) encoded by SEQ ID NO: 1 [SEQ ID NO: 3 is part or fragment of SEQ ID NO: 2] in

specific association with a polypeptide of SEQ ID NO: 15, classified in class 435, subclass 194.

Group 13, claim(s) 5 (in-part), drawn to an isolated complex comprising Density Enhanced Phosphatase-1 (DEP-1) of SEQ ID NO: 2, SEQ ID NO: 3, or a polypeptide (SEQ IDNO: 2) encoded by SEQ ID NO: 1 [SEQ ID NO: 3 is part or fragment of SEQ ID NO: 2] in specific association with a polypeptide of SEQ ID NO: 22, classified in class 435, subclass 194.

Group 14, claim(s) 6-9, drawn to a method of identifying an agent that alters interaction of a DEP-1 polypeptide, wherein the DEP-1 substrate polypeptide is
a polypeptide of SEQ ID NO: 4, classified in class 435, subclass 21.

Group 15, claim(s) 6-9, drawn to a method of identifying an agent that alters interaction of a DEP-1 polypeptide, wherein the DEP-1 substrate polypeptide is
a polypeptide of SEQ ID NO: 5, classified in class 435, subclass 21.

Group 16, claim(s) 6-9, drawn to a method of identifying an agent that alters interaction of a DEP-1 polypeptide, wherein the DEP-1 substrate polypeptide is
a polypeptide of SEQ ID NO: 6, classified in class 435, subclass 21.

Group 17, claim(s) 6-9, drawn to a method of identifying an agent that alters interaction of a DEP-1 polypeptide, wherein the DEP-1 substrate polypeptide is
a polypeptide of SEQ ID NO: 7, classified in class 435, subclass 21.

Group 18, claim(s) 6-9, drawn to a method of identifying an agent that alters interaction of a DEP-1 polypeptide, wherein the DEP-1 substrate polypeptide is
a polypeptide of SEQ ID NO: 8, classified in class 435, subclass 21.

Group 19, claim(s) 6-9, drawn to a method of identifying an agent that alters interaction of a DEP-1 polypeptide, wherein the DEP-1 substrate polypeptide is
a polypeptide of SEQ ID NO: 9, classified in class 435, subclass 21.

Group 20, claim(s) 6-9, drawn to a method of identifying an agent that alters interaction of a DEP-1 polypeptide, wherein the DEP-1 substrate polypeptide is
a polypeptide of SEQ ID NO: 10, classified in class 435, subclass 21.

Group 21, claim(s) 6-9, drawn to a method of identifying an agent that alters interaction of a DEP-1 polypeptide, wherein the DEP-1 substrate polypeptide is
a polypeptide of SEQ ID NO: 11, classified in class 435, subclass 21.

Group 22, claim(s) 6-9, drawn to a method of identifying an agent that alters interaction of a DEP-1 polypeptide, wherein the DEP-1 substrate polypeptide is
a polypeptide of SEQ ID NO: 12, classified in class 435, subclass 21.

Group 23, claim(s) 6-9, drawn to a method of identifying an agent that alters interaction of a DEP-1 polypeptide, wherein the DEP-1 substrate polypeptide is
a polypeptide of SEQ ID NO: 13, classified in class 435, subclass 21.

Group 24, claim(s) 10-17, drawn to a recombinant expression construct comprising a polynucleotide encoding a DEP-1 polypeptide of SEQ ID NO: 2 or 3, host cell & cell line, classified in class 435, subclass 252.3.

Group 25, claim(s) 18-25, drawn to a method of altering transduction of a biological signal in a cell, by introducing into the cell a DEP-1 polypeptide of SEQ ID NO: 2 or 3, that is specifically associated with a DEP-1 substrate polypeptide of SEQ ID NO: 4, classified in class 435, subclass 252.3.

Group 26, claim(s) 18-25, drawn to a method of altering transduction of a biological signal in a cell, by introducing into the cell a DEP-1 polypeptide of SEQ ID NO: 2 or 3, that is specifically associated with a DEP-1 substrate polypeptide of SEQ ID NO: 5, classified in class 435, subclass 252.3.

Group 27, claim(s) 18-25, drawn to a method of altering transduction of a biological signal in a cell, by introducing into the cell a DEP-1 polypeptide of SEQ ID NO: 2 or 3, that is

specifically associated with a DEP-1 substrate polypeptide of SEQ ID NO: 6, classified in class 435, subclass 252.3.

Group 28, claim(s) 18-25, drawn to a method of altering transduction of a biological signal in a cell, by introducing into the cell a DEP-1 polypeptide of SEQ ID NO: 2 or 3, that is specifically associated with a DEP-1 substrate polypeptide of SEQ ID NO: 7, classified in class 435, subclass 21.

Group 29, claim(s) 18-25, drawn to a method of altering transduction of a biological signal in a cell, by introducing into the cell a DEP-1 polypeptide of SEQ ID NO: 2 or 3, that is specifically associated with a DEP-1 substrate polypeptide of SEQ ID NO: 8, classified in class 435, subclass 21.

Group 30, claim(s) 18-25, drawn to a method of altering transduction of a biological signal in a cell, by introducing into the cell a DEP-1 polypeptide of SEQ ID NO: 2 or 3, that is specifically associated with a DEP-1 substrate polypeptide of SEQ ID NO: 9, classified in class 435, subclass 21.

Group 31, claim(s) 18-25, drawn to a method of altering transduction of a biological signal in a cell, by introducing into the cell a DEP-1 polypeptide of SEQ ID NO: 2 or 3, that is specifically associated with a DEP-1 substrate polypeptide of SEQ ID NO: 10, classified in class 435, subclass 21.

Group 32, claim(s) 18-25, drawn to a method of altering transduction of a biological signal in a cell, by introducing into the cell a DEP-1 polypeptide of SEQ ID NO: 2 or 3, that is specifically associated with a DEP-1 substrate polypeptide of SEQ ID NO: 11, classified in class 435, subclass 21.

Group 33, claim(s) 18-25, drawn to a method of altering transduction of a biological signal in a cell, by introducing into the cell a DEP-1 polypeptide of SEQ ID NO: 2 or 3, that is specifically associated with a DEP-1 substrate polypeptide of SEQ ID NO: 12, classified in class 435, subclass 21.

Group 34, claim(s) 18-25, drawn to a method of altering transduction of a biological signal in a cell, by introducing into the cell a DEP-1 polypeptide of SEQ ID NO: 2 or 3, that is specifically associated with a DEP-1 substrate polypeptide of SEQ ID NO: 13, classified in class 435, subclass 21.

2. The inventions are distinct, each from the other because of the following reasons:

Each of the protein complexes of Group(s) 1-13 are structurally as well as in activity levels distinct complexes and therefore these Inventions are patentably distinct.

Each of the recombinant DNA constructs of Groups 24-27, are distinct structurally as well as in the level(s) of expression, and therefore these Groups are patentably distinct.

Each of the recombinant expression constructs comprising the nucleic acids of Group 24-27 may be related to the protein complexes of Group 1-13 by virtue of encoding at least a portion of the protein comprising the complex. However, they are distinct inventions because the protein product can be made by another and materially different process, and further, the DNA may be used for processes other than the production of the protein, such as nucleic acid hybridization assay.

Each of the methods of Groups 14-23 & Groups 28-34 require different products and steps and have different endpoints. Therefore, Inventions Groups 14-23 & Groups 28-34 are patentably distinct.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Applicants are advised that the reply to this requirement MUST include an election of the invention to be examined, even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tekchand Saidha whose telephone number is (571) 272 0940. The examiner can normally be reached on 8.30 am - 5.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (571) 272 0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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